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MAY 22 2008

In re Application of: HUGHES-BAIRD et al. :  
Appl. No.: 10/086,014 : DECISION ON PETITION  
Filed: February 28, 2002 :  
For: GAMING DEVICE HAVING IMPROVED OFFER :  
AND ACCEPTANCE GAME WITH MASKED OFFERS :

This is a decision on the petition filed on April 9, 2008 by which petitioner requests entry of the Reply Brief filed January 28, 2008 and entry of the Amendment to Cancel Claims filed concurrently therewith. Petitioner was notified of the denial of entry of the Reply Brief and Amendment in the Advisory Action mailed March 19, 2008. The petition is stylized as submitted under 37 CFR 1.181, is considered timely, and no fee is due.

The petition is GRANTED.

Review of the application shows application claims 1-10, 18 and 20 were finally rejected by the Office on October 13, 2006. Claims 11-17, 21 and 22 stand allowed. Petitioner filed a Notice of Appeal on January 9, 2007, followed by a Brief on March 9, 2007. This Brief was held non-compliant by the Office on July 9, 2007. A compliant Brief was submitted by petitioner on July 20, 2007. The Office promulgated and Examiner's Answer on November 27, 2007. Responsive thereto, petitioner filed a Reply Brief and Amendment on January 28, 2008. Petitioner's Amendment proposed to cancel dependent claims 6, 7, 9 and 10 only.

In the Advisory action of March 19, 2008 the examiner denies entry of the Reply Brief and Amendment stating "the proposed cancellation of claims 6, 7, 9, and 10 would alter the claim scope of the language "directly and individually" in the remaining claims and therefore is improper for entry." The advisory action fails to explain how the deletion of the particular dependent claims would affect the meaning of the language "directly and individually" in the remaining non-related dependent claims or in the independent claim. This position can not be supported.

37 CFR 41.33 (b)(1) [in pertinent part] states:

§ 41.33 Amendments and affidavits or other evidence after appeal.

...

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 maybe admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

...

37 CFR 1.75 [in pertinent part] states:

**§ 1.75 Claim(s).**

(a) *The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.*

(b) *More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.*

(c) *One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.*

...  
*Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.*  
...

Petitioner submits cancellation of each of dependent claims 6, 7, 9 and 10, each separately dependent individually from independent claim 1, does not affect the scope of any other pending claim in the proceeding and therefore the amendment cancelling these claims is allowed entry under 37 CFR 41.33 (b)(1) and therefore seeks entry of the amendment and Reply Brief. Petitioner points to specific reasoning for this position, particularly with respect to claims 9 and 10 being set forth in the Reply Brief accompanying the allegedly offending amendment.

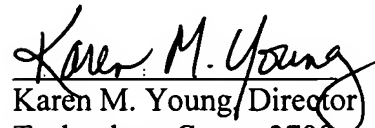
Looking to the claims, the language in question of claim 1 includes: "... (a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections, ...". This claim covers at least one disclosed embodiment shown in Figs 3a and 3b and discussed at least at page 13 lines 3-5 of the specification, and said embodiment includes each offer associated with a separate selection. Claim 7 recites in pertinent part "... associate one of said offers with each of said selections." Claim 9 recites in pertinent part "... each of said offers is only associated with one selection." Claim 10 recites in pertinent part "... said offers may be associated with a plurality of selections". As can be appreciated, each of claims 7, 9 and 10 fails to meaningfully further limit claim 1 as each repeats an offer associated with one selection, and therefore cancellation thereof under 37 CFR 41.33 (b)(1) is permissible.

Claim 6 recites in pertinent part "... the number of offers is less than the number of selections." This is disclosed on page 13, lines 1-3 with respect to the same embodiment that claim 1 appears directed to. This means that while the player may be presented with a total of five offers, the values associated with each offer have been selected from a pool of selections containing greater than five values. The language of claim 6 appears to further limit claim 1 in that claim one is silent with respect to the number of offers or the number of selections (note claim one merely defines the *association* such that each offer is associated with a separate one of the selections). When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). Office personnel must also avoid reading limitations from other claims into a particular claim as much as they must guard reading limitations from the specification into the claims. In the instant application, cancellation of claim 6 does not alter the scope of claim 1 or any other pending claim. Therefore, cancellation thereof under 37 CFR 41.33 (b)(1) is permissible.

Cancellation of claims 6, 7, 9 and 10 is therefore allowed under 37 CFR 41.33 (b)(1). Further, petitioner's Reply Brief of January 28, 2008 is timely and ripe for entry under 37 CFR 41.41 (a)(1). Jurisdiction of the file is returned to the primary examiner for acknowledgement of the cancellation of claims 6, 7, 9 and 10 and entry/consideration of the Reply Brief.

Any inquiry regarding this decision may be directed to J. Harrison at 571-272-4449.

PETITION GRANTED

  
Karen M. Young, Director  
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